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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,420	08/26/2003	Charles C. Anderson	83879D-W	3994
7590	01/11/2005		EXAMINER ZACHARIA, RAMSEY E	
Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			ART UNIT 1773	PAPER NUMBER

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/648,420

**Applicant(s)**

ANDERSON ET AL.

**Examiner**

Ramsey Zacharia

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 36-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-35 and 41 is/are allowed.
- 6) ☒ Claim(s) 42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Election/Restrictions*

2. Applicant's election with traverse of Group I in the reply filed on 03 November 2004 is acknowledged. The traversal is on the ground(s) that the product was designed for use in the process claimed and its use in a different process is speculative with highly unpredictably chances for success. Furthermore, the element and the use of the element are so closely related that a search for one would necessarily overlap the search for the other and would therefore not be burdensome for the examiner to search both groups of claims.

This is not found persuasive because the product as claimed is not required to be used in the process of claims 36-40. Claim 36 is drawn to a process for producing an electrode pattern while claim 1 is drawn merely to an element. If it is not possible to use the product in any other process, then the product as claimed would not be enabled by the instant disclosure. Moreover, the fact that the inventions have acquired a separate status in the art as was shown by their different classification (Group I in class 428 and Group II in class 427) constitutes a *prima facie* showing of a serious burden on the Examiner. See MPEP § 803.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 36-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the reply filed on 03 November 2004.

4. This application contains claims drawn to an invention nonelected with traverse in the reply filed on 03 November 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 42 and 43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an article in which the resistivity of the areas contacted with the printing solution decrease by at least a factor of 10, does not reasonably provide enablement for an article in which the resistivity of the areas contacted with the printing solution decrease by any factor less than 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Page 9, lines 13-15 of the instant specification state that "[a]fter printing and drying, the resistivity of the areas that were contacted with the printing solution decreases by at least a factor of 10". Therefore, an article in which the resistivity of the areas contacted with the printing solution decrease by any factor less than 10 are outside the scope of the instant invention.

7. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an article in which a printing solution comprising a conductivity enhancing agent is in contact with the organic electroconductive polymeric layer, does not reasonably provide enablement for an article in which the printing solution is not in contact with the organic electroconductive polymeric layer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification describes only articles in which the printing solution containing the conductivity enhancing agent contacts the organic electroconductive polymeric layer (see page 4, lines 25-30, page 5, lines 1-5 and 11-14, and the Examples). There is no disclosure or teaching indicating that the printing solution can lower the resistivity without being in contact with the organic electroconductive polymeric layer. It appears that the printing solution must contact the organic electroconductive polymeric layer to obtain the claimed effect on resistivity. This position is further supported on page 13 of the remarks filed 03 November 2004 wherein the applicants argue that the application of covering layer between the organic electroconductive polymeric layer and the applied printing solution would prevent the increase in conductivity needed in the present invention.

***Allowable Subject Matter***

8. Claims 1-35 and 41 are allowed.
9. The following is a statement of reasons for the indication of allowable subject matter.

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The invention of claim 1 is directed to an element comprising an organic electroconductive polymeric layer disposed on a support. A printing solution containing a conductivity enhancing agent is applied in contact with the organic electroconductive polymeric layer such that the resistivity of the contacted areas decreases by at least a factor of 10 below  $1 \times 10^6 \Omega$ .

Savage et al., Jonas et al., and Cloots et al. represent the closest prior art. However, none of these references teach or fairly suggest an article comprising an organic electroconductive polymeric layer having a layer containing a conductivity enhancing agent printed thereon such that the resistivity of the areas contacted by the printing decrease below  $1 \times 10^6 \Omega$  by a factor of at least 10. Furthermore, the obviousness-type double patenting rejection has been withdrawn because none of the claims of copending Application No. 10/648,418 require the presence of the electrographic developer or marking particles and copending Application No. 10/648,418 does not require that the resistivity be decreased below  $1 \times 10^6 \Omega$  by a factor of at least 10.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period




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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Ramsey Zacharia**  
**Primary Examiner**  
**Tech Center 1700**